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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,989	03/31/2004	Roy K. Greenberg	8627-372	8184

757 7590 11/19/2008
BRINKS HOFER GILSON & LIONE
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CHICAGO, IL 60610

EXAMINER

PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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11/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/814,989	Applicant(s) GREENBERG ET AL.	
	Examiner Pedro Philogene	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-16, 18, 20-22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-16, 18, 20-22, 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/19/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/3/08 has been entered.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e)—or—120-- as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/003,011, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Applicant fails to provide adequate disclosure in the prior application for a "retraction mechanism that biases the

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actuation section and hence the grasping portion towards a retracted states". Since, the drawings and specification of application No. 10/814,989, are the original presentation of a retraction mechanism that biases the actuation section and hence the grasping portion towards a retracted states, applicant's claim for benefit is 3/31/2004, the filing date of the 10/814,989 application. Accordingly, claims 1-22 are not entitled to the benefit of the prior application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 13-16, 18, 20-22, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates (5,944,728) in view of Teague et al. (7,322,989) in view of Denison et al. (7,252,675).

With respect to claims 1, 24, Bates disclose a medical grasping device comprising: an elongate control member (23) having an atraumatic distal tip section (22), as best seen in FIG.1, and a proximal end portion; the elongate control member further including a grasping portion (16) proximal the distal tip section; an outer sheath (14) with a passageway therethrough, as best seen in FIG.1, surrounding the elongate control member and relatively movable with respect thereto.

Although Bates teaches of an actuation section, as set forth in column 4, lines 1-67, it is noted that Bates, did not teach of an actuation section, as claimed by applicant.

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However, in a similar art, Teague et al., column 6, lines 38-42; column 7, lines 1-63; column 8, lines 12-25; provide the evidence of such an actuation section with retraction mechanism that biases the actuation section proximally causing a relative motion between the elongate control member and the sheath urging the grasping portion towards a retracted state to enable the control deployment and displacement of a device.

Therefore, given the teaching of Teague et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the actuation mechanism, as taught by Teague et al, in the device of Bates, to bias the actuation section to enable the control deployment and displacement of the grasping portion.

Furthermore, when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show it was obvious under 35 U.S.C. 103. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385,1396 (2007). Therefore, it would have been obvious to try an actuation section, as taught by Teague et al., in order to bias the actuation section and hence the grasping portion towards a retracted state.

With respect to claims 2-11, the above combination of references teaches all the limitations, as set forth in Bates, column 3, lines 45-67, column 4, lines 1-67, column 5, lines 1-67, column 6, lines 1-61 and as best seen in FIGS.1-7; also as set forth in

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Teague et al, column 6, lines 38-42, column 7, lines 1-63, column 8, lines 12-25; and as best seen in FIGS.8-11.

It is noted that the above combination of references teaches all the limitations, except for wire loops that are substantially circular upon full deployment, that is pie shaped, each loop having an arcuate outer section, the arcuate outer sections cooperating to form a circular perimeter substantially perpendicular to a longitudinal axis of the elongate control member, each arcuate outer section having a radius about equal to a radius of the circular perimeter, each wire loop having an opening, the openings cooperating to substantially fill the circular perimeter, further wherein the elongate control member distally relative to the outer sheath expands the circular perimeter and cooperatively expands the radius of the arcuate outer section thereby increasing the openings of the wire loop to again substantially fill the circular perimeter, a size and radius of loops adjusting along with the circular perimeter to substantially fill the circular perimeter; as claimed by applicant. However, in a similar art, Denison et al provide the evidences of the use of pie shaped wire loops (50, 56; FIGS: 6A-6C, 11,12) that are circular upon full deployment and having side sections that overlap and touch the vessel wall to engage the object to be retrieved with a greater force.

Therefore, given the teaching of Denison et al, it would have been obvious to one having ordinary skill in the art, at the time the invention was made to incorporate the design of the grasping device of Denison et al in the grasping device of Bates/Teague et al. to engage the object to be retrieved with a greater force.

With respect to claims 13-16, 18, 20-22, Denison et al disclose all the limitations, as set forth in column 11, lines 46-67, column 12, lines 1-67, column 13, lines 12-57.

Response to Amendment

Applicant's arguments, see Remarks, filed 9/3/08, with respect to the rejection(s) of claim(s) 1-23 under 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Denison et al. The examiner agrees with applicant that Hillstead does not teach the radius of the loop changing so that the loops cooperate to substantially fill an adjustable circular perimeter. However, Denison et al provides the evidences of the use of a radius of a loop changing so that the loops cooperate to substantially fill an adjustable circular perimeter; as best seen in FIG.6A-6c.

Conclusion

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/
Primary Examiner, Art Unit 3733
November 17, 2008